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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,932	01/20/2000	Richard Alan Fiedotin	10160-02-999	3747

20583 7590 12/17/2003

PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 100362711

EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/487,932

Applicant(s)

FIEDOTIN ET AL.

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-26 are presented for examination.

#### ***Response to Amendment***

2. The declaration filed on 9/22/2003 under 37 CFR 1.131 is sufficient to overcome the ParkStone, Menduno, and med-I-nets references. However, new grounds of rejection are established in the instant office action based on 35 USC 103 as set forth in detail below.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al., Pat. No. 5,737,539 (hereinafter Edelson) in view of Bennahum, David, "Docs for Docs" (hereinafter Bennahum).

As to claim 1, Edelson discloses A method for distributing medical data to medical personnel (see abstract), said method comprising the steps of: storing medical data in a database (col. 8, lines 4-31); and

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periodically communicating selected medical data between said database and an electronic device to establish a medical data distribution system (col. 7, lines 10-31)

Edelson does not explicitly disclose

a data distribution system subsidized by sponsoring entities.

However, Bennahum discloses a data distribution system subsidized by sponsoring entities (page 3, paragraphs 1 and 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a data distribution system subsidized by sponsoring entities as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

As to claim 2, Edelson discloses A method according to claim 1, wherein said method further comprises the initial step of aggregating said medical data from multiple sources col. 7, lines 21-31).

As to claim 3, Edelson discloses A method according to claim 2, wherein said aggregating step further comprises collecting medical data selected from a group consisting of formulary and pharmacopoeia data (col. 8, lines 11-19 and col. 21 - col. 22).

As to claim 4, Edelson does not explicitly disclose A method according to claim 1, wherein said method further comprises the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system.

However, Bennahum discloses wherein said method further comprises the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system (page 3, paragraphs 1-2 and page 4, paragraphs 1-3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said method further comprises the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

As to claim 5, Edelson does not explicitly disclose A method according to claim 4, wherein said selling step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract research organization or a managed care organization.

However, Bennahum discloses wherein said selling step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract research organization or a managed care organization (page 3, paragraph 1 and page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said selling

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step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract research organization or a managed care organization as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

As to claim 6, Edelson does not explicitly disclose A method according to claim 1, wherein said method further comprises the initial step of distributing said electronic device, at a subsidized or no cost, to medical personnel.

However, Bennahum discloses wherein said method further comprises the initial step of distributing said electronic device, at a subsidized or no cost, to medical personnel (page 4, paragraphs 1-3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said method further comprises the initial step of distributing said electronic device, at a subsidized or no cost, to medical personnel as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

As to claim 7, Edelson does not explicitly disclose A method according to claim 6, wherein said distributing step comprises lending a handheld computing device to a physician, where said handheld computing device is subsidized by said sponsoring entities.

However, Bennahum discloses wherein said distributing step comprises lending a handheld computing device to a physician, where said handheld computing device is subsidized by said sponsoring (page 4, paragraphs 1-3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said distributing step comprises lending a handheld computing device to a physician, where said handheld computing device is subsidized by said sponsoring entities as disclosed by Bennahum within Edelson for the motivation of providing the data distribution system service free so that doctors will use the system ( page 3, paragraph 1).

As to claim 8, Edelson and Bennahum do not explicitly disclose A method according to claim 1, wherein said method further comprises the step of placing indicia of the sponsored entity on said electronic device.

However, the Examiner takes official notice that it was well known in the electronic device arts to place indicia of a sponsoring entity on an electronic device. For example, cellular phone companies provide cellular phone services to customers. Oftentimes, these cellular phone companies provide rebates or reduced prices on cellular phones manufactured by other companies in conjunction with introductory cellular phone services. The telephone, in addition to containing the indicia of the manufacturer also contains an indicia of the cellular phone company providing the rebate or discount. The purpose of the indicia is to draw the customer's attention to the cellular phone service provider's identity, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said method further comprises the

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step of placing indicia of the sponsored entity on said electronic device within the Edelson and Bennahum combination for the motivation stated above.

As to claim 9. Edelson discloses A method according to claim 1, wherein said communicating step further comprises the steps of receiving a request for medical data from said electronic device (col. 12, lines 22-42 and col. 37, lines 53-67); and responding to the request by sending at least a portion of said medical data to said electronic device (col. 12, lines 22-42 and col. 37, lines 53-67).

As to claim 10. Edelson A method according to claim 1, wherein said communicating step further comprises the steps of sending a query to said electronic device (Fig 3-10); and receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query (Fig 3-10).

As to claim 11, Edelson discloses A method according to claim 1, wherein said communicating step further comprises the step of downloading executable instructions to the electronic device, wherein said executable instructions are capable of running on the electronic device (col. 7, lines 10-27).

As to claims 12-26, the claims are substantially similar to claims 1-11 and are rejected on the same basis.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

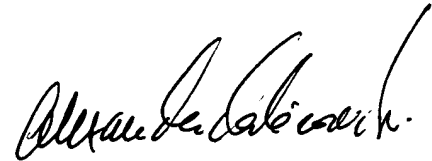


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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

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12/15/03